REMARKS

The present communication is responsive to the Final Office Action mailed February 2, 2001. Applicants also appreciate the willingness of Examiner Choi and Primary Examiner Peterson to conduct a personal interview on the above-identified patent application on February 13, 2001.

Applicants respectfully assert that the present Amendment After Final should be entered because the proposed Amendment places the application in condition for allowance and does not create any new issues for consideration by the Examiner.

The Examiner rejected claim 39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 2,346,100 to Wright (hereinafter "*Wright*") in view of U.S. Patent 1,122,558 to Vertunni et al. (hereinafter "*Vertunni*"). Referring to FIG. 1 thereof, *Wright* discloses a shearing machine for cutting a stack placed atop a moveable platen 7. In operation, a pedal 30' is depressed for elevating link 25 rocking lever 33 and lowering pinion 35. The downward movement of pinion 35, in turn, urges slides 38 and 39 in a downward vertical direction toward the moveable platen 7. The slides 38 and 39 may move concurrently or one after the other until the progress of one of the slides is impeded by an obstruction. When one of the slides is impeded, the other slide moves until there is a resistance to its movement equal to the resistance to movement upon the other slide. When clamp 58 and cutter 59 engage the stack being cut, the clamp and cutter apply substantially equal pressures are applied to stack A to effect both shearing and clamping of the stack. In other words, when clamp 58 is stopped by its engagement with stack A, the continued downward movement of pinion 35 in cooperation with stationary rack 36 causes a counterclockwise rotation of pinion 35, the application of force to pinion 37 being sufficient to drive cutter 59 downward through stack A and into moveable platen 7. As a result, after clamp 58 and cutter 59 have engaged stack

A, substantially equal forces are applied to clamp 58 and cutter 59 tending to move them toward platen 7. As a result, the pinion 35 and opposing racks 36, 37 act as equalizing mechanisms distributing forces transmitted through lever 33 to clamp 58 and cutter 59 proportionately to the relative resistance to the respective movements thereof offered by the stack A.

Referring to FIGS. 1-4 thereof, *Vertunni* discloses a shearing machine including a knife blade 21 moveable between a first position shown in FIG. 1 and a second position shown in FIG. 2. As shown in FIGS. 2 and 3 of *Vertunni*, an object is cut by a shearing action when blade 21 passes closely by a lower corner 46 of vertical flange 45 (col. 2, lines 95-112).

In response to the Examiner's Section 103(a) rejection of claim 39, claim 38 has been amended to incorporate the limitations of claim 39 therein. Amended claim 38 is unobvious and allowable because the Examiner has not demonstrated all of the elements of a *prima facie* case of obviousness. As set forth by the Court of Appeals for the Federal Circuit, "[i]f the examination at the initial stage does not produce a *prima facie* case of patentability, then without more the Applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). Specifically, the Examiner has failed to establish a *prima facie* case of obviousness with respect to amended claim 38 because the Examiner has provided no reason, suggestion or motivation from the prior art as a whole for a person of ordinary skill to combine or modify the references. As explained by the Board of Patent Appeals and Interferences:

> When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the Examiner to explain why combination of the reference teachings is proper . . . Absent such reasons or incentives, the teachings of the references are not combinable.

Ex Parte Skinner, 2 U.S.P.Q.2d 1788, 1790 (B.P.A.I. 1987).

Moreover, Applicants respectfully assert that the Examiner has used the claimed invention as a road map for piecing together the prior art.

As stated by the Court of Appeals for the Federal Circuit:

> It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

In re Fritch, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1982).

Thus, amended claim 38 is unobvious and allowable because the Examiner has pointed to no suggestion or motivation provided by the *Wright* and *Vertunni* references as to why one skilled in the art would be motivated to combine the references as suggested by the Examiner. Moreover, the prior art references actually teach away from the claimed combination because *Wright* discloses a shearing machine having a cutting blade that moves along an axis that is perpendicular to a cutting surface. As a result, the cutting blade compresses the material being cut, a result that the present application considers to be highly undesirable. See Applications' Specification at page 19, lines 1-12. Thus, one of ordinary skill in the art would be discouraged from following the path set forth in the *Wright* reference, and/or would be directed to a path that diverges from the path taken by Applicants in the above-identified patent application. See *In re Gurley*, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994).

Claim 38 is also unobvious because the suggestion to combine the *Wright* and *Vertunni* references comes from the patent

application itself. In other words, an Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. As stated by the Federal Circuit:

> Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

ACS Hosp. Sys., Inc. v. Montefiore Hosp., 221 U.S.P.Q. 929 (Fed. Cir. 1984).

Clearly, the cited references provide no incentive for being combined in the manner suggested by the Examiner.

Amended claim 38 is also unobvious because the Examiner has failed to appreciate that Applicant's discovery of the problem solved by the present invention is also a factor that must be analyzed when considering the patentability of inventions. Amended claim 38 is drafted in recognition of a special problem related to cutting the ends of window shades comprising a head rail, a bottom rail and slats therebetween without creating a crack or uneven cut line. This particular problem has remained unsolved for a considerable length of time and has only been solved by providing a cutting apparatus including a cutting blade having "a first component of movement extending in a direction substantially parallel to said cutting surface and a second component of movement extending in a direction substantially perpendicular to said cutting surface." The discovery of this unique problem by Applicants is evidence of the patentability of claim 38. As stated by the Court of Customs and Patent Appeals:

> It should not be necessary for this Court to point out that a patentable invention may lie in the discovery of a source of a problem even though the remedy may be obvious once

> the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.

In re Nomiya, 184 U.S.P.Q. 607, 612 (C.C.P.A. 1975).

Applicants respectfully assert that the modification proposed by the Examiner is improper because the proposed modification to *Wright* would render the prior art invention being modified unsatisfactory for its intended purpose M.P.E.P. §2143.01. Combining the *Wright* and *Vertunni* references as suggested by the Examiner would result in the inoperability of the *Wright* reference. Specifically, in order to modify *Wright* as suggested by the Examiner, the slides 38, 39 would have to be placed at an angle relative to the top surface of platen 7. Such modification would have to be made so that Wright's cutter blade 59 (FIG.1) could move with "a first component of movement extending in a direction substantially parallel to said cutting surface and a second component of motion extending in a direction substantially perpendicular to said cutting blade", as required by claim 38. Such modification would also result in clamp 58 engaging stack A from a side angle and not from directly above, thereby forcing stack A to move across the cutting surface. In addition, if the modification suggested by the Examiner were made, the cutting edge of blade 59 would not remain "substantially parallel to the substantially flat cutting surface during movement along the movement axis", as also required by claim 38.

In view of the above-noted amendment and remarks, Applicants respectfully assert that amended claim 38 is unobvious over the combination of *Wright* and *Vertunni*, and is otherwise allowable. Claim 39 has been cancelled. Claims 3-8 and 11-37 are also allowable by virtue of their dependence from claim 38,

which is allowable for the reasons set forth above. Although not set forth herein, Applicants assert that claims 3-8 and 11-37 are separately allowable, and the patentability of these claims is not solely based upon their dependence from claim 38.

In view of the above Amendment and remarks, Applicants respectfully request that the Examiner withdraw his rejection and allow the case. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone Applicants' attorneys at (908) 654-5000 in order to overcome any additional objections which may remain.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Respectfully submitted,

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